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IN THE

Supreme Court of the United States

OCTOBER TERM, 1968

No. 565

EDWARD FREDKIN, *Petitioner*

v.

EUGENE H. IRASEK

PETITIONER'S REPLY BRIEF

ROBERT H. RINES
DAVID RINES
Rines and Rines
Ten Post Office Square
Boston, Massachusetts
02109

NELSON H. SHAPIRO
Washington Building
Washington, D. C.

Attorneys for Petitioner

November, 1968

PRESS OF BYRON S. ADAMS PRINTING, INC., WASHINGTON, D. C.

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THE ACTUAL QUESTION PRESENTED

It is desired to high-light to this Honorable Court that respondent has conceded that there was, as your petitioner has stated, a

> "refusal of the Court below to look into the question of respondent's disclosure" *

to see if

> "his application lacks that requisite disclosure";

since, respondent admits,

> "If the lack did exist, *the claim of course would be invalid* for lack of compliance with Section 112 of Title 35 U.S. Code." (page 2, emphasis added.)

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* Pages 5 and 6 of respondent's brief.

While stating that respondent does not concur that the Court considered it "lacked power to act" to prevent allowance of an invalid claim (page 2), the respondent does fully agree with your petitioner, that in the "refusal of the Court below to look into the question", the Court of Customs and Patent Appeals gave as its only reason that the obtaining of

> "a patent with an invalid claim . . . . *is not a matter that can be considered here*". (page 3, emphasis supplied).

The substance of your petitioner's "Question Presented" (p. 2 of petition) thus appears to be conceded; and it remains to determine whether this issue is of sufficient importance to warrant the time of this Court.

RESPONDENT'S REASONS FOR ASSERTING NO NECESSITY FOR REVIEW BY THE SUPREME COURT

While, as above pointed out, the respondent has agreed (page 3) with your petitioner's assertion that the Court of Customs and Patent Appeals has declined *even to consider* ("not a matter that can be considered here") whether a patent claim is or is not invalid, this is justified, in respondent's view, upon four grounds:

1. The jurisdiction of the Court of Customs and Patent Appeals only runs to "the limited issue of priority of invention", citing 35 U.S.C. Sec. 144, and the matter of patentability "is still open to reconsideration by the Examiner" on remand; so that there is a "fail-safe" provision against granting the invalid claim (pages 4, 5).

2. There is no public interest since only a "pending patent *application*" is allegedly involved and not a patent (page 5).

3. To give the Court the power to pass on invalidity at any time, whether originally raised in the early interference proceedings or otherwise, would lack "orderly administrative procedure for *inter partes* determination of issues of priority".

4. This does not "disregard . . . the public interest".

The answers to these four grounds are simple.

Ground 1

As for ground 1, (namely, does the jurisdiction of the Court of Customs and Patent Appeals, as provided for in 35 U.S.C. Sec. 144 printed on page 10 of respondent's brief, run only to "the limited issue of priority of invention"), *this is precisely the issue your petitioner has raised:*

What is the jurisdiction and power of the Court of Customs and Patent Appeals?

Is it less than any other Article III Court in its inherent power and duty to pass on patent claim invalidity?

Can a court pass on so-called priority of a patent claim (who is the first inventor) while ignoring whether that patent claim is invalid so that priority could even be awarded?

As for the so-called "fail-safe" procedures, in this case the Patent Office (Board of Patent Interferences) *has also refused* to look into the matter of invalidity for lack of disclosure, since your petitioner, through "misunderstanding", had not earlier raised the issue. *The "fail-safe" is thus gone!* (They similarly refused to look into the matter with regard to count 3, which

respondent concedes, page 3, "petitioner had questioned *at the outset*", by a timely motion.)

It should be noted that the admission of the party Irasek that what he disclosed in his patent application was not a "magnetic coupling", as called for by count 4 (page 5 of petition) did not come until *long after the motion periods,* during testimony. Both the Patent Office and the Court of Customs and Patent Appeals refused to consider *such* testimony because your petitioner wasn't clairvoyant enough to anticipate it during the motion periods!!

In other words, no matter what the testimony shows, neither the Patent Office nor the Court of Customs and Patent Appeals apparently has a duty to consider the same insofar as it relates to patent claim validity, unless the matter was raised at the outset of the proceeding *before* testimony.

This squarely *raises* the most important question of petitioner:

> "Now that it is an Article III Court, is the Court of Customs and Patent Appeals *powerless,* as it has specifically held in this case, to protect the public by preventing the issuance of an admittedly invalid patent claim. . . ." (p. 2 of petition).

This appears to be a most vital question for prompt resolution, particularly since there is continued concern and conflict within the Court of Customs and Patent Appeals itself as to its powers and jurisdiction in its new Article III setting (see dispute in that Court in *Swingline Inc.* v. *Kleinert Rubber Company,* 399 F. 2d 283 (1968), 285 "this court is an Article III Court—giving rise to the obligation to act like one—".)

Ground 2

In ground 2, respondent tries to stress that only a patent "application" is involved, not a patent, so that the public interest is not involved.

Had a patent been involved, respondent appears to concede that the prior decisions of the Supreme Court make a determination of invalidity a prime task of Article III Courts.

Actually, however, a *patent* is involved, since the respondent copied the c' ims in question from the issued *patent* of petitioner, not a patent application.

Thus respondent apparently concurs with petitioner that the matter of validity of a *patent* claim is decidedly in the public interest.

Ground 3

As pointed out under ground 1, this case involves testimony that occurred *long after* the motion period; so that the material of such testimony could hardly have been anticipated or predicted earlier.

This case does not thus involve any disorderly administrative procedure.

It involves only the normal conduct of Article III courts!

Ground 4

As above shown, it is of great importance to the public to settle promptly the power, jurisdiction and duty of the Court of Customs and Patent Appeals as to invalidity of patent claims, now that it is an Article III Court.

Since this is the only appellate court from the Patent Office, the urgency is all the more evident.

It is thus respectfully submitted that the issue of this case is well worth the time of the Supreme Court to resolve.

ROBERT H. RINES
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